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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

MCKELVEY, TERRY ALAN

ART UNIT	PAPER NUMBER
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1636

DATE MAILED: 06/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/043,774

Applicant(s)

SHARMA ET AL.

Examiner

Terry A. McKelvey

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-9,11-13 and 17-24 is/are pending in the application.
- 4a) Of the above claim(s) 3,9,11 and 17-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-8,12 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

All objections and rejections not repeated in the instant Action have been withdrawn due to applicant's response to the previous Action.

Election/Restrictions

Claims 3, 9, 11, and 17-24 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the paper filed 11/12/03.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4-8, and 12-13 are rejected under 35

U.S.C. 102(a) as being anticipated by Sharma et al. This

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rejection is maintained for reasons of record set forth in the paper mailed 12/18/03. Applicants' arguments filed 3/18/04 have been fully considered but they are not deemed to be persuasive.

Sharma et al teach a nucleic acid that 100% matches SEQ ID NO:1 (and thus would hybridize to SEQ ID NO:1 under hybridization conditions), that comprises a nucleotide sequence which encodes hiwi of SEQ ID NO:2 (pages 427-428). See the attached sequence comparison. A recombinant expression vector comprising a nucleotide sequence encoding hiwi, and the vector in a cell culture, is taught (page 428).

Response to Arguments

The applicant essentially argues that the unsigned declaration filed 3/18/04 overcomes the instant rejection and that a signed copy is forthcoming. This argument is not persuasive because the signed copy has not been received and until a signed proper declaration is received, the instant rejection remains of record.

Claims 12-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Lin (WO 00/32039). This rejection is maintained for reasons of record set forth in the paper mailed 12/18/03.

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Applicants' arguments filed 3/18/04 have been fully considered but they are not deemed to be persuasive.

Lin et al teach an isolated nucleic acid (SEQ ID NO:5 in the reference) which comprises a nucleotide sequence encoding human piwi, designated human hiwi (pages 5-6; page 10; claim 14). See the attached sequence comparison. A recombinant expression vector comprising the nucleic acid is taught (claim 23). A cell culture transformed with a recombinant expression vector expressing human hiwi is also taught (claims 26 and 29). Because of the high degree of similarity, the nucleic acid taught by the reference would hybridize to SEQ ID NO:1.

Response to Arguments

The applicant argues that amended claim 1 is drawn to an isolated nucleic acid that encodes SEQ ID NO:2, which is different from SEQ ID NO:6 in the reference, and thus does not anticipate the pending claims. This argument is not persuasive because claims 12-13 are drawn nucleic acids that hybridize to SEQ ID NO:1, and not to nucleic acids that encode SEQ ID NO:2. The applicant did not specifically address the limitations of claims 12-13 in arguing that the instant rejection should be withdrawn.

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Conclusion

No claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Certain papers related to this application may be submitted to Art Unit 1636 by facsimile transmission. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). The official fax telephone number for the Group is 703-872-9306. NOTE: If Applicant does submit a paper by fax, the original signed copy should be

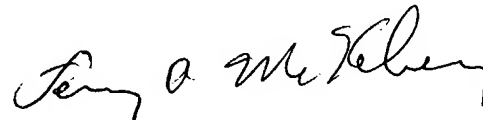
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retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning rejections or other major issues in this communication or earlier communications from the examiner should be directed to Terry A. McKelvey whose telephone number is (703) 305-7213 until January 14, 2004, and (571) 272-0775 after January 14, 2004. The examiner can normally be reached on Monday through Friday, except for Wednesdays, from about 7:30 AM to about 6:00 PM. A phone message left at this number will be responded to as soon as possible (i.e., shortly after the examiner returns to his office).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Remy Yucel can be reached on (703) 305-1998.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



Terry A. McKelvey, Ph.D.
Primary Examiner
Art Unit 1636

May 28, 2004